

REMARKS

STATUS OF CLAIMS

Claims 1-18 are pending.

Claim 17 is objected to for informalities.

Claims 1-18 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

Claims 2-13 are rejected under 35 USC 112, second paragraph, as being indefinite.

Claims 1-3, 6-9, and 14-18 are rejected under 35 USC 103(a) as being unpatentable over Blakely (WO 01/27859) in view of Gardenswartz (US Patent No. 6,298,330).

Claims 4, 10, 11 are rejected under 35 USC 103(a) as being unpatentable over Blakely, Gardenswartz and Hoffberg (US Patent No. 6,252,544).

Claims 5, 12 and 13 are rejected under 35 USC 103(a) as being unpatentable over Blakely, Gardenswartz, and Gough (US Patent No. 6,360,221).

Claims 1-6, 11, 13, 14, 16, and 18 are amended.

Thus, claims 1-18 remain pending for reconsideration, which is respectfully requested.

No new matter has been added in this Amendment. The foregoing rejections are hereby traversed.

Claim Objection

In item 1, on page 2 of the Office Action, the examiner objected to claim 17 due to informalities. Specifically, the examiner suggested that the term "shop side" in the first element of claim 17 should be "shop" by deleting the phrase "side." However, the rationale for such deletion is not provided by the Examiner, and the term "shop side" is repeatedly used in the Specification, for example, at page 8, lines 18-22, page 9, lines 9-13, page 11, line 31, page 13, lines 23-25, page 19, line 7, etc, thereby providing support for the claimed recitation "shop side."

For example, page 19, lines 4-10 and FIG. 1, expressly provide support for the term "shop side," so that the claim 17 recitation, "a prospective customer notifying part for receiving a prospective customer list that is a search result of prospective customers of an advertising article from a customer database accessible from an advertisement distribution server, and presenting the list to a shop side; ..." clarifies that the prospective custom list is presented to a

shop side.

Therefore, withdrawal of the objection to claim 17 is respectfully requested.

Claim Rejections Under 35 U.S.C. § 101

On pages 2-5 of the Office Action, the Examiner provides detailed reasons for rejecting claims 1-18 under 35 USC §101 as being directed to non-statutory subject matter. Specifically, on page 2, the Examiner asserts: "Claims 17-18 do not provide a concrete, useful, and tangible result. The claims should include a positive step of ad delivery in order to accomplish such a result." The Examiner also asserts: "Claims 1-18 are not within the technological arts." The Examiner also asserts on page 5 of the Office Action: "In the present application, the body of the claims do not set forth at least one computer-based feature responsible for providing a non-trivial feature of the invention."

Upon a closer examination of the claims, the Applicants note that the last element of independent claims 1-3, 6, 14, 16, and 18 already recite delivering name-embedded advertisement to customers, which the Examiner is requiring to be recited in the claims as a concrete, useful, and tangible result. Therefore, the claims already recite a concrete, useful and tangible result by reciting ad delivery operations, as follows.

Using claim 1 as an example, as part of concrete, useful and tangible ad delivery, claim 1 recites, "searching for prospective customers of an advertising article from customer information," "searching for shops ... from shop information," "creating a prospective customer list of the prospective customers," "generating name-embedded advertisement," and "distributing the name-embedded advertisement to the prospective customers selected to receive the name-embedded advertisement."

Independent claims 14 and 16-17 are directed, respectively, to an advertisement distributing system, an advertisement distributing server, and an advertisement distributing client. For example, independent claim 14 recites, "a prospective customer searching part for searching for prospective customers of an advertising article from **a customer database**" (claim 14, emphasis added). For example, independent claim 16 recites, "a prospective customer searching part for searching for prospective customers of an advertising article from **an accessible customer database**" (claim 16, emphasis added). For example, independent claim 17 recites, "the advertisement distributing **client requesting the advertisement distributing server to distribute** the advertisement to customers who are specified to receive the advertisement" (claim 17, emphasis added).

Independent claim 18 is amended to improve the preamble form thereof by expressly providing that the computer-readable recording medium stores a processing program to control a computer according to the claimed processes of the present invention.

Therefore, the Examiner already acknowledges that ad delivery is a concrete, useful, and tangible result, and claims already recite concrete, useful and tangible ad delivery operations. Also if a claim recites producing a useful, concrete, and tangible result, the claim is limited to a practical application, and is therefore statutory. MPEP at §2106(IV)(B)(2)(b)(ii); State Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). Withdrawal of the 35 USC 101 rejection is respectfully requested, because the independent claims 1-3, 6, 14 and 16-18 recite a concrete, useful and tangible result by positively reciting concrete, useful and tangible processes of ad delivery to accomplish such a result, and are within the technological arts.

Claim Rejections Under 35 USC §112, 2nd Paragraph

In item 3, on pages 5-6 of the Office Action, the Examiner gave his detailed reasons for rejecting claims 2-13 under § 112, second paragraph. Claims 1, 2, 3, 6 are amended taking into consideration the Examiner's comments. Withdrawal of the indefiniteness rejections under 35 USC 112, second paragraph, is respectfully requested.

Further, independent claims 1, 14, 16 and 18, and dependent claims 4, 5, and 11, are amended to improve form only, and the claim amendments are not narrowing claim amendments for purposes of overcoming the relied upon prior art to reject the claims.

Blakely Is An Improper 35 USC 103 Reference

Because Blakely was published on April 19, 2001 (after the present Application U.S. filing date of December 18, 2000), the Examiner cannot use Blakely as a §103 reference based on §§102(a) or 102(b). Therefore, the Examiner is attempting to use Blakely as a §103 reference based on §102(e).

However, 35 USC 102(e), as explained in the MPEP § 2136.03(II), requires that, for the international filing date of an international application to be used as its § 103(e) date, three conditions must be met:

- (1) the international filing date is on or after November 29, 2000;
- (2) the international application designated the United States; and
- (3) the international application was published in English.

Blakely designated the United States and was published in English (satisfying requirements 2 and 3), but Blakely's international filing date is October 12, 1999, which is before November 29, 2000. As explained in MPEP §706.02(a), "[n]o international filing dates prior to November 29, 2000 may be relied upon as a prior art date under 35 U.S.C. 102(e)..." As a result, Blakely is only available as a §103 reference as of its International Publication Date of April 19, 2001, which is after the U.S. filing date December 18, 2000 of the present Application, such that Blakely is not a proper prior art to reject the claims of the present US patent Application. Because Blakely is an invalid prior art reference, and because it is used as the primary reference for all of the rejections under §103, withdrawal of the 35 USC 103 rejections of claims 1-18 is respectfully requested.

However, to expedite prosecution, the Applicants submit the following remarks concerning the Examiner's remarks on (1) the Applicant's admission on page 6 of the Office Action in attempting to reject the independent claims 1-3, 6, 14 and 16-18, (2) the Examiner's inherency remarks, and (3) the Examiner's takings of Official Notice concerning dependent claims 4, 10 and 11.

Applicants' Admissions

In item 5, on pages 6 and 7 of the Office Action, the Examiner stated that the Applicant admitted "the known use of opt-out and opt-in advertising." (Office Action, p. 6-7). After reviewing the Specification, the Applicants note that although the Related Art section of the Specification describes "opt-in" advertisement (e.g., page 3, lines 12-16 of the Specification), there is no description regarding "opt-out" advertisement in the Related Art section of the Specification. For example, page 6, lines 3-10 of the Specification do not describe an "opt-out" advertisement. Therefore, the following Examiner's statement "the Applicant admitted the known use of opt-out advertisement at the time of filing" is not correct, because the Applicant did not admit the same in the Related Art section of the Specification, notwithstanding if a general "opt-out" advertisement was known at the time of filing of the present Application. In other words, the Related Art section of the present Specification does not admit the present claimed invention concerning "opt-out" advertising.

Official Notice of Dependent Claims 4, 10 and 11

Regarding dependent claims 4, 10 and 11, in items 6 and 7, on page 7 of the Office Action, the Examiner took Official Notice that it was well known in the art at the time of filing "to charge the manufacturer as well as retailer for provided advertising." (Office Action, p. 7). However, there is no term "manufacturer" in claims 4, 10 and 11, so that the Examiner's

understanding of dependent claims 4, 10 and 11 should be clarified as follows. Even if the Examiner exemplifies a manufacturer as the present claimed invention's "advertisement provider" recited in dependent claims 4, 10 and 11, in contrast to Hoffberg the present claimed invention, using dependent claim 4 as an example, provides calculating two types of fees, (1) an advertisement fee charged to an advertisement provider by "setting an advertisement unit price for billing an advertisement provider per advertisement with respect to the advertisement of the article" and "multiplying the advertisement unit price by the number of name-embedded advertisements distributed in the name-embedded advertisement distributing operation," and (2) an advertisement distribution shop fee charged the shop, which is:

calculated by adding a product obtained by multiplying the prospective customer distribution fee unit price by the number of name-embedded advertisements distributed to the prospective customers, to a product obtained by multiplying the regular customer distribution fee unit price by the number of name-embedded advertisements distributed to the regular customers.

In particular, the advertisement distribution shop fee comprises two portions of "prospective customer distribution fee" and "regular customer distribution fee" (dependent claim 4).

The Examiner asserts that the present invention as recited in dependent claims 4, 10 and 11 is well known and relies on Hoffberg. However, Hoffberg cannot support the Examiner's well known assertion of the present claimed advertisement billing, because dependent claims 4, 10 and 11 do not merely recite "to charge the advertisement provided as well as retailer," as suggested by the Examiner, but the dependent claims 4, 10 and 11 recite other patentably distinguishing features. And Hoffberg only mentions advertising fees generated in a mobile communications device, and in column 26, lines 5-6, provides one example of "allowing accounting for advertising fees on an impression basis," which differs from the present claimed two types of fees charged and calculated for an advertisement provider and the shop. Hoffberg's "impression" basis advertising fees would be tied to a location, perceived events, time and/or other factors, of the mobile communication device, but Hoffberg is absolutely silent on the present claimed invention's calculating two types of fees, (1) an advertisement fee charged to an advertisement provider by "setting an advertisement unit price for billing an advertisement provider per advertisement with respect to the advertisement of the article" and "multiplying the advertisement unit price by the number of name-embedded advertisements distributed in the name-embedded advertisement distributing operation," and (2) an advertisement distribution shop fee charged the shop, which is "calculated by adding a product obtained by multiplying the

prospective customer distribution fee unit price by the number of name-embedded advertisements distributed to the prospective customers, to a product obtained by multiplying the regular customer distribution fee unit price by the number of name-embedded advertisements distributed to the regular customers.” In particular, for example, Hoffberg does not disclose or suggest the present claimed invention’s advertisement distribution shop fee that comprises two portions of “prospective customer distribution fee” and “regular customer distribution fee” (dependent claim 4). Further, Hoffberg’s column 22, lines 25-29 and column 25, lines 49-65, do not disclose or suggest the present claimed invention as recited in dependent claims 4, 10 and 11.

Therefore, the Examiner’s taking of Official Notice is hereby traversed, and allowance of dependent claims 4, 10 and 11, is respectfully requested.

Inherency

In item 5, on pages 6-7 of the Office Action, the Examiner asserted several inherencies at the time of filing, namely: (1) “searching store information for stores that are capable of selling the identified product which is the subject of the advertising,” (2) “periodically updat[ing] the store’s information regarding which customers are opting-out of advertising as the customers respond to the opt-in advertising opportunities,” and (3) using “such updated information … for the most recent ad delivery times.” (Office Action, p. 6-7).

First, the Applicants assert regarding the independent claims 1-3, 6, 14 and 16-18, that the present claimed invention’s “a shop searching operation of searching for shops that are capable of selling the article to the prospective customers from shop information,” is not inherent, because either Blakely or Gardenswartz do not disclose or suggest such shop searching, and the Examiner asserts inherency without providing any documentary evidence. In particular, Blakely discloses an advertiser 10 selecting both a prospect from a prospects list 22 and a commercial from a commercial list 24 and identifies those selections to a third party 30 (page 2), which does not disclose or suggest the present claimed invention’s shop searching. Further, Gardenswartz discloses target advertisement based upon cookies and an offline purchase history of a consumer associated with the cookie (Abstract). Therefore, Gardenswartz also does not disclose or suggest the present claimed invention’s shop searching. Therefore, in view of these two relied upon references, the present claimed invention’s “a shop searching operation of searching for shops that are capable of selling the article to the prospective customers from shop information” cannot be inherent.

Second, in the last paragraph of item 5 of the Office Action, the Examiner states that

"regarding claim 8, it would have been inherent to have periodically updated the store's information regarding which customers are opting out of advertising as the customers respond to the opt-in advertising opportunities; such update information is inherently used for the most recent ad delivery times."

However, the Examiner's statement is not related to the subject matter of dependent claim 8, which in contrast to the relied upon references and the Examiner's inherency provides,

wherein information representing a ***distribution starting time of the advertisement is prescribed to be an advertisement distribution starting requirement,***

in the advertisement distribution selecting operation, ***selection of the prospective customers is accepted until the time represented by the advertisement distribution starting requirement,*** and

on the time represented by the advertisement distribution starting requirement, the name-embedded advertisement generating operation and the name-embedded advertisement distributing operation are conducted (emphasis added).

Therefore, the Examiner's inherency allegations are hereby traversed.

Lack Of Motivation To Combine/Modify The References

In detailing the § 103 rejections, the Examiner did not sufficiently assert the motivation to combine or modify the references. Specifically, the Examiner only provided a purported benefit of the combinations/modifications without any supporting facts from the references or elsewhere. The Examiner did not make any findings of fact, nor did the Examiner provide the requisite level of specificity necessary to support a *prima facie* case of obviousness.

MPEP § 706.02(j) sets forth the contents of a rejection under § 103: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure" (emphasis in original). *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143-2143.03 for decisions pertinent to each of these criteria.

Factual findings in support of a *prima facie* case of obviousness must be supported by

substantial evidence. *In re Zurko*, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001). MPEP 2144. The Examiner has provided no such substantial evidence in support of the Examiner's conclusion that it would have been obvious to combine Blakely and Gardenswartz or to modify such a combined system to achieve the claimed invention, because as discussed above, at least Blakely and Gardenswartz and a combined system thereof do not disclose or suggest the present claimed invention's as recited for example in claim 1:

a prospective customer searching operation of searching for prospective customers of an advertising article from customer information;

a shop searching operation of ***searching for shops that are capable of selling the article to the prospective customers from shop information;***

a prospective customer notifying operation of ***creating a prospective customer list of the prospective customers, to which the shops are capable of selling the article, on a shop basis, and notifying the shops of the prospective customer list,***

an advertisement distribution selecting operation of ***allowing the shops to determine whether or not an advertisement regarding the article is to be distributed to the prospective customers in the notified prospective customer list,***

a name-embedded advertisement generating operation of generating name-embedded advertisement in which shop identity information capable of identifying the shops is added to the advertisement previously registered; and

a name-embedded advertisement distributing operation of ***distributing the name-embedded advertisement to the prospective customers selected to receive the name-embedded advertisement in the advertisement distribution selecting operation*** (e.g., amended claim 1, emphasis added).

Other independent claims recite patentably distinguishing features of their own.

CONCLUSION

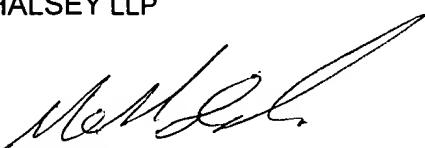
In view of the remarks, withdrawal of the rejections of claims 1-18 and allowance of claims 1-18 is respectfully requested.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Respectfully submitted,
STAAS & HALSEY LLP

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By: 
Mehdi D. Sheikerz
Registration No. 41,307

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501